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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,508	10/19/2001	Dan Kikinis	007287.00051	4578
22907 7590 10/05/2007 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER BUI, KIEU OANH T	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 10/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/029,508

Applicant(s)

KIKINIS, DAN

Examiner

KIEU-OANH BUI

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Types of “channels” critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Regarding all claims, “a set of channels” are considered vague and indefinite; and they are not referred to whether “radio channels”, “television channels” or “data stream channels” or else. Although the examiner understands this application relates to a method and a system in the television field; however, claims must be presented in a positive and clearly defined manner.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al. (U.S. Patent No. 6,029,045) in view of Bennington et al. (U.S. Patent 6,373,528 B1).

Regarding claim 1, Picco discloses a same method as a first set of (television) channels based on a predetermined criteria related to a viewer's preference, and also inserting into the first set of channels a first channel not selected (by the viewer) based on the predetermined criteria related to the viewer's preference (refer to col. 3/line 43 to col. 4/line 12 for local content can be added to the viewer's channel at some predetermined time based on the predetermined criteria of the viewer's preference; and col. 6/lines 17-41 for advertisements are inserted into a broadcasting channel which is not selected by the viewer, yet the content is related to the viewer's preference based on the predetermined criteria).

Picco does not further providing a first set of channels "in a channel list" (as amended); however, Bennington teaches a same technique of setting a set of channels "in a channel list" selected based on the predetermined criteria related to the viewing preference (Bennington, Figs. 7-8 for a preference menu to set up a favorite channel list—meaning a channel list based on the predetermined criteria related to the viewing preference, and col. 19/line 48 to col. 20/line 56). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

Art Unit: 2623

was made to modify Picco's system with Bennington's teaching favorite channel list as disclosed in order to insert the (preferred) channel list into Picco's system as taught by Picco (col. 6/lines 57-67).

As for claim 2, Picco teaches this feature as the system operator inserts the content into a first channel of the first set of channels (col. 5/lines 19-54). The modified "in the channel list" are disclosed earlier in view of Bennington's.

As for claim 3, Picco teaches this feature as the system disallows the insertion when some content does not match the criteria related to the viewing preference (Fig. 9, at steps 234 & 236, col. 13/lines 42-52). The modified "in the channel list" are disclosed earlier in view of Bennington's.

As for claim 4, Picco further teaches this feature as the time expiration for the displaying content on the channel can be predetermined (col. 6/line 62 to col. 7/line 6). The modified "in the channel list" are disclosed earlier in view of Bennington's.

As for claim 5, Picco further teaches this feature as the viewer statistics can be collected and used for targeting appropriate local contents based on the viewer's geographic location (col. 6/line 62 to col. 7/line 32 for users' data or profile is collected within a local area). The modified "in the channel list" are disclosed earlier in view of Bennington's.

As for claim 6, Picco teaches this feature as the channel is selected based on a predetermined subject matter (col. 6/lines 17-41 for an example of "automobiles" as a predetermined subject matter of automobile is presented). The modified "in the channel list" are disclosed earlier in view of Bennington's.

Art Unit: 2623

For claims 7-18, these claims with same limitations addressed earlier are rejected for the reasons given in the scope of claims 1-6 in view of Picco and Bennington as disclosed in details above.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to PTO New Central Fax number:

(571) 273-8300, (for Technology Center 2600 only)

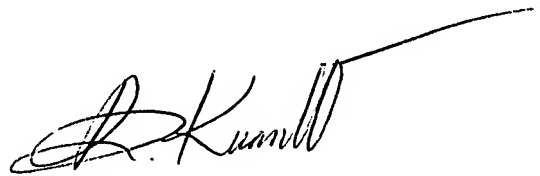
*Hand deliveries must be made to Customer Service Window,
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.*

Art Unit: 2623

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner can normally be reached on Monday-Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller, can be reached at (571) 272-7353.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'K. Bui', with a long horizontal line extending from the end of the signature.

Kieu-Oanh Bui
Primary Examiner
Art Unit 2623

KB
Oct. 01, 2007